

REMARKS

This Amendment is in response to the Final Rejection mailed January 29, 2004. The Examiner's comments in that Action have been carefully considered. A check in the amount of \$950.00 is enclosed to pay for an extension fee of three months, to re-set the due date for response from April 29, 2004, to July 29, 2004. This Amendment is filed with a Request for Continued Examination (RCE) and a second check, for \$770.00, to cover the continuation filing fee.

All claims 1, 3-7 and 9-12 of record have been rejected as being obvious on the basis of the previously cited Shpiro et al. reference (U.S. Patent No. 5,487,671) in view of or when combined with the newly cited secondary reference to Adams, Jr. et al. (U.S. Patent No. 6,017,219), for reasons set forth in paragraph 5 of the Final Rejection. However, for reasons more specifically set forth below, the applicant respectfully traverses this rejection and requests that it be reconsidered and withdrawn

as to all claims now of record: claims 1, 3-7 and 9-14.

The Examiner states that Shpiro et al. teaches all the limitations of the subject application except for the plurality of reference pronunciation data corresponding to a plurality of pronunciation fluency levels, for the same language, and a user operative member for selecting one of the plurality of these pronunciation fluency levels. However, the Examiner applies Adams, Jr. et al. as teaching these features – the plurality of reference pronunciation data and the user operative member.

Initially, Shpiro et al., although he discloses an interactive training apparatus for a word or vowel, does not teach a training apparatus for a sentence (see column 7, lines 65-67). Furthermore, Adams, Jr. et al. merely teaches a reading or language interactive system that implements a shared reading program in which portions of the text are read by the student and portions are read by the computer itself. The proportion of the text “read” by each, and the pace at which the lesson progresses, can be automatically

altered according to the proficiency of the student (see the Abstract of the Disclosure). The lesson levels range from "beginners," in which all of the lesson is read by the computer instructor or computer companion, to the most advanced, in which the student performs all of the reading him- or herself (column 6, lines 39-42). However, there is no teaching in Adams, Jr. et al. that would provide a database for storing a plurality of reference pronunciation data for a sentence of the same language, nor is there anything corresponding to a plurality of pronunciation fluency levels for the sentence and a user operative member so that he or she can select one of a range of said plurality of pronunciation fluency levels.

Also, the Examiner has not provided any support for the proposal that the references be combined as he suggests. Adams, Jr. et al. reference neither teaches nor even remotely suggests the elements or features allegedly missing from Shpiro et al., and this confirms that there is no incentive to combine without the hindsight of the subject application and

the teachings contained therein.

Obviousness cannot be established by combining the teachings of prior art references to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination found in the prior art. Carella v. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). More recently, the Court of Appeals of the Federal Circuit has held that the U.S. Patent and Trademark Office erred in rejecting the claimed invention as an obvious combination of the teachings of two prior art references where the prior art provided no teaching, suggestion or incentive supporting the combination. In re Bond, 910 F.2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990). See also In Symbol Technologies, Inc. v. Opticon, Inc., 935 F.2d 1569, 19 USPQ 2d 1241 (Fed. Cir. 1991). The Court of Appeals of the Federal Circuit stated:

We do not “pick and choose among individual elements of assorted prior art references to recreate the claimed invention,” but rather we look for “some teaching or suggestion in the references to support

their use in the particular claimed combination.”

See also In re Bell, 991 F. 2d 781, 26 USPQ 2d 1529 (Fed. Cir. 1993) and In re Lowry, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994). The Court of Appeals of the Federal Circuit has consistently followed this rule. In a very recent decision, this principle was reaffirmed in Sensonics, Inc. v. Aerosonic Corp., 81 F. 3d 1566, 38 USPQ 2d 1551 (Fed. Cir. 1996), where the Court observed that there was no teaching or suggestion in the prior art referreances which would cause a person of ordinary skill to have been led “to select various mechanical and electrical structures and concepts and combine them as did the inventor.” It is respectfully submitted that the same is true in this case. The combination proposed by the Examiner is clearly based upon a mosaic hindsight approach, that is, it uses the present application and the teachings contained therein as a road map for picking and choosing isolated elements from prior art references.

For all these reasons, it is believed that it would not be obvious to

U.S. Patent Application of Kojima
Serial No.: 09/856,393 – Art Unit: 2654

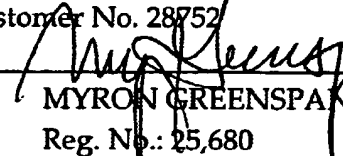
combine the references as proposed by the Examiner, and all obviousness
rejections under 35 U.S.C. §103(a) must accordingly be untenable.

It is believed that this application is now in condition for allowance.

Early allowance and issuance, therefore, are respectfully solicited.

Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. COSTS FOR SUCH EXTENSION(S) AND/OR ANY OTHER FEE DUE WITH THIS FEE DUE WITH THIS PAPER THAT ARE NOT FULLY COVERED BY AN ENCLOSED CHECK MAY BE CHARGED TO DEPOSIT ACCOUNT #10-0100

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Express Mail Certification

I hereby certify that this correspondence, including a RCE Transmittal Form, a check for \$950.00, a check for \$770.00 and a return card, is being filed by depositing same in an Express Mail envelope marked Mail Stop RCE, Commissioner for Patents, Alexandria, VA 22313-1450, with Express Mail tracking no. EV 076 592 609 US, at a duly authorized U.S. Postal Service drop box or Post Office, with appropriate postage, on the following date:

Myron Greenspan

Name

Signature

July 29, 2004

Date



FROM Customer No. 28752

RE: (1) Amendment After Final Rejection and Request for Reconsideration
(2) Request for Continued Examination (RCE)

Re: "Pronunciation Judgment System"

Inventor: Kojima

Serial No.: 09/856,393

Filed: May 22, 2001

Our Docket No.: P-0105 S

Comprising:

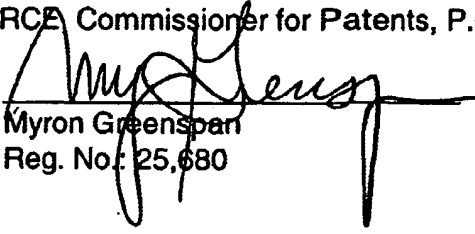
- (1) Amendment After Final Rejection and Request for Reconsideration
Containing: request for three-month extension of time
- (2) Check for \$950.00 in payment of three-month extension of time
- (3) Request for Continued Examination (RCE) Transmittal
- (4) Check for \$770.00 in payment of filing fee for continued application
- (5) Return card

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Date of Deposit: July 29, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop RCE Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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Dated: July 29, 2004

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